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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,539	08/27/2001	Stephane Fouquay	58779.000017	2787

7590 10/15/2004

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EXAMINER

TRAN. THAO T

ART UNIT PAPER NUMBER

1711

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/938,539

Applicant(s)

FOUQUAY ET AL.

Examiner

Thao T. Tran

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to the Amendments filed on August 02, 2004.
2. Claims 1-22 are currently pending in this application. Claims 12 and 14-22 have been withdrawn from further consideration as being drawn to a non-elected invention.
3. Claims 1-11 and 13 have been elected without traverse in the Response filed on February 5, 2004.

### ***Specification***

4. In view of the prior Office action of April 01, 2004, the objection to the disclosure has been withdrawn due to the Amendments made thereto.

### ***Claim Objections***

5. Claim 6 is objected to because of the following informalities: line 10, "f the composition" should be changed to --of the composition--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. In view of the prior Office action of April 01, 2004, the rejection of claim 6, under 35 U.S.C. 112, first paragraph, has been withdrawn due to the Amendments made thereto.
7. In view of the prior Office action of April 01, 2004, the rejection of claims 2 and 6, under 35 U.S.C. 112, second paragraph, has been withdrawn due to the Amendments made thereto.

*Claim Rejections - 35 USC § 103*

8. In view of the prior Office action of April 01, 2004, the rejection of claims 1-5, 7-11, and 13, under 35 U.S.C. 103(a) as being unpatentable over Hirano et al. (US Pat. 5,326,881), has been withdrawn due to the Amendments made thereto.

9. Claims 1-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lallier et al. (US Pat. 6,001,192) in view of Mitsuhashi et al. (US Pat. 5,599,954).

Lallier teaches a composition and a method of making, the composition comprising an aprotic polar solvent (TPA), an ether (TE), and an activator (TA) (see col. 1, ln. 40-52; col. 2, ln. 40). Lallier further teaches the solvent being dimethylsulfoxide or dimethyl formamide, the ether being dioxolane or methoxytetrahydrofuran, having a molar volume of less than 160 having several methoxy groups (see col. 2, ln. 12-20).

In regards to claims 1-5 and 13, Lallier, however, differs from the presently claimed invention because Lallier does not teach a specific activator as recited in the instant claims.

Mitsuhashi teaches a composition comprising a mixture of ethers comprising tetrahydrofuran and acetonitrile, and a mixture of activators comprising imidazole (see col. 6, ln. 59-65).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the activators, as taught by Mitsuhashi, in the composition of Lallier, because the use of an ether activator, such as imidazole, would have activated the reaction forward and would have yielded the product better.

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With respect to the use of the composition for surface treatment of polyester resin, it has been held that recitation on intended use would have no significant patentable weight.

In regards to claims 6-8, Lallier further teaches the aprotic polar solvent and the ether are present in a volume ratio of 50/50 (see col. 2, ln. 10).

In regards to claims 9, Lallier teaches the ether having a flash point higher than 0oC (see col. 1, ln. 47), and not specifically higher than 100oC. However, since Lallier teaches the same ether in the same composition, the flashing point of Lallier would inherently be the same as that of the instant invention.

In regards to claims 10-11, Lallier teaches the ether to be dimethoxybenzene (see col. 2, ln. 14-16).

### ***Response to Arguments***

10. Applicant's arguments with respect to the rejection of claims 1-5, 7-11, and 13, under 35 U.S.C. 103(a) as being unpatentable over Hirano et al. (US Pat. 5,326,881), have been considered but are moot in view of the new ground(s) of rejection above.

### ***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt  
October 12, 2004



THAO T. TRAN  
PATENT EXAMINER